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Hilgers Bell & Richards
Attorneys at Law

816 Congress, Suite 1200
Austin, Texas 78701
Phone (512) 476-0005
Fax (512) 476-1513
www.hbrfirm.com

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MICHAEL O. SCHEINBERG
Of Counsel

mscheinberg@hbrfirm.com

November 6, 2006

Fax

Name: Petitioner Examiner – Douglas I. Wood
Organization: United States Patent and Trademark Office
Art Unit: 3785
Fax: 1-571-273-0025, 1-571-273-8300
Tel: 1-571-272-3282

From: Michael O. Scheinberg
Hilgers, Bell & Richards LLP
816 Congress Avenue
Suite 1200
Austin, TX 78701
Phone: (512) 476-0005
Fax: (512) 476-1315
Date: November 6, 2006
Subject: Renewed Petition
Atty. Docket No.: HSS-30
Pages: 4 (including this coversheet)

APPLICATION NO.: 10/656,080 ART UNIT: 3745
FILING DATE: September 5, 2003 PETITIONER EXAMINER: Douglas I. Wood
INVENTOR: Heribert Vogel
TITLE: Rotor System for a Remotely Controlled Aircraft

In connection with the above-identified patent application, applicants submit the following:

1. Renewed Petition (3 p.)

Michael O. Scheinberg
Patent Reg. No.: 36,919

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FILING DATE: September 5, 2003

PETITIONS EXAMINER: Douglas I. Wood

INVENTOR: Heribert Vogel

TITLE: Rotor System for a Remotely Controlled Aircraft

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**RENEWED PETITION**

Applicants request reconsideration of the 12 October 2006 Decision (the "Decision") dismissing applicant's 19 September 2006 Petition Under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. § 1.55(a)(2) (the "Petition") for two reasons:

1. Relief is not precluded by the statute as amended in 1999; and
2. 35 U.S.C. § 119 is not applicable because priority is claimed under 35 U.S.C. § 120, not 35 U.S.C. § 119.

The Decision stated that relief was precluded by 35 U.S.C. § 119 (1994), which required a certified copy of the priority document to be filed in the Office. 35 U.S.C. § 119 was revised in 1999 by Public Law 106-113, effective November 29, 2000, to make the requirement for deposit of a certified copy discretionary with the Director, rather than mandatory by statute. The revised statute states: "The director may require a certified copy of the original foreign application . . ." [emphasis added].

Because the revised statute is permissive with regard to whether or not the Director may require filing the certified copy, the statute does not preclude the relief requested by the applicant. The Director would not violate the statute by waiving the requirement that the copy be certified by the German Patent Office in the interest of judgment because the Director may waive the requirement for the certified copy altogether. Applicant submits that because the German Patent Office has certified that it cannot provide a certified copy, and because the Certification by WIPO removes any doubt of the authenticity of the copy provided to the Office, there is no detriment to the public and no reason not to grant the petition.

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Furthermore, in accordance with 35 U.S.C. § 363, the present application claims priority under 35 U.S.C. § 120 from PCT/EO02/02154; it does not claim foreign priority under 35 U.S.C. § 119. 35 U.S.C. § 363 states "An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title."

Applicant submits, therefore, that the requirement for the certified copy of the priority document under 35 U.S.C. § 119 is not applicable. By analogy, when foreign priority under 35 U.S.C. § 119 has been established in a parent case, and the applicant files a continuation case under 35 U.S.C. § 120, the rules do not require the applicant to submit additional certified copies of the foreign priority documents in the continuation case filed under 35 U.S.C. § 120. After the foreign priority is established in the parent case, it is accepted in the continuation under 35 U.S.C. § 120. In the present case, certified copies of the priority documents were provided to the International Bureau of WIPO and accepted in the parent case, *i.e.*, PCT/EO02/02154.

Had the applicant filed in the US as a national phase entry under 35 U.S.C. § 371, the Office would clearly not require a certified copy of the German priority application, and applicant submits that there is no reason to interpret the rules to require a certified copy with a continuation under filed 35 U.S.C. § 120 from a PCT application.

The Decision suggests that applicants submit a copy of the German priority document from WIPO to the German Patent Office and request that it certify the copy. The German Patent Office has already certified that no copy is available at the German Patent Office. It would therefore be unable to certify a copy provided to them, when they no longer have the original with which to compare the copy.

Applicant has done everything possible to comply with the requirement of 37 C.F.R. § 1.55. The acceptance of the priority claim by WIPO in the parent case and the filing in the USPTO of a copy certified by WIPO leaves no doubt about the existence and content of the priority application, and makes a copy available to the public in the files of the USPTO.

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Because there is no detriment to the public, and no alternative to the applicant, applicant respectfully requests reconsideration of his Petition and that the requirement of a certified copy under 37 CFR § 1.55(a)(2) be waived.

Respectfully submitted,

Date: November 6, 2006

By:



Michael O. Scheinberg
Pat. Reg. No.: 36,919
P.O. Box 164140
Austin, TX 78716-4140
Telephone: (512) 476-0005
Fax: (512) 476-1513